

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY


(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

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Applicant's or agent's file reference 30A-90 964		FOR FURTHER ACTION See Form PCT/IPEA/416	
International application No. PCT/EP 03/04268	International filing date (day/month/year) 24.04.2003	Priority date (day/month/year) 24.04.2002	
International Patent Classification (IPC) or national classification and IPC H04Q7/30			
Applicant TELEFONAKTIEBOLAGET LM ERICSSON (PUBL)			
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 8 sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input checked="" type="checkbox"/> sent to the applicant and to the International Bureau a total of 5 sheets, as follows:</p> <p><input checked="" type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>			
<p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the opinion</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input checked="" type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input checked="" type="checkbox"/> Box No. VIII Certain observations on the international application</p>			
Date of submission of the demand 17.11.2003		Date of completion of this report 10.08.2004	
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465		Authorized Officer Wolf, W Telephone No. +49 89 2399-7930	



**INTERNATIONAL PRELIMINARY REPORT
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Box No. I Basis of the report

1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language , which is the language of a translation furnished for the purposes of:
- ☐ international search (under Rules 12.3 and 23.1(b))
 - ☐ publication of the international application (under Rule 12.4)
 - ☐ international preliminary examination (under Rules 55.2 and/or 55.3)
2. With regard to the **elements*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):*

Description, Pages

1-21 as originally filed

Claims, Numbers

1-27 received on 22.03.2004 with letter of 22.03.2004

Drawings, Sheets

1/8-8/8 as originally filed

- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing (*specify*):
 - ☐ any table(s) related to sequence listing (*specify*):
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages
 - ☐ the claims, Nos.
 - ☐ the drawings, sheets/figs
 - ☐ the sequence listing (*specify*):
 - ☐ any table(s) related to sequence listing (*specify*):

* If item 4 applies, some or all of these sheets may be marked "superseded."

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Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1-27
	No: Claims	
Inventive step (IS)	Yes: Claims	
	No: Claims	1-27
Industrial applicability (IA)	Yes: Claims	1-27
	No: Claims	

2. Citations and explanations (Rule 70.7):

see separate sheet

Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

V. Reasoned statement under Rule 66.2(a)(ii) with regards to novelty, inventive step and industrial applicability; citations and explanations supporting such statement

- A -

The following documents (D) are mentioned for the first time in this written opinion; the numbering will be adhered to in the rest of the procedure:

- D1: GB-A-2 352 127 (ERICSSON TELEFON AB L M) 17 January 2001 (2001-01-17)
- D2: US 2001/006895 A1 (DELLA MEA FABRICE) 5 July 2001 (2001-07-05)
- D3: US 2001/024960 A1 (MAUGER RAPHAELLE) 27 September 2001 (2001-09-27)
- D4: ETSI: 'Digital Cellular telecommunication system (phase 2+) (GSM); Universal Mobile Telecommunications System (UMTS); Inband Tandem Free Operation (TFO) of speech codecs; Service Description; Stage 3 (3GPP TS 28.062 version 5.0.0 Release 5)' ETSI TS 128 062 V5.0.0, [Online] March 2002 (2002-03), XP002248624 Retrieved from the Internet:
<URL:<http://www.etsi.org>>

- B -

1. Independent **claim 1** does not meet the requirements of Article 33(3) PCT concerning **inventive step**.

Indeed, D2, discloses, according to the main features of claim 1, *a method of initiating the bypassing of a pair of transcoding operations performed in series by a first transcoder arranged together with a first communication terminal on a local side of a communication network and by a second transcoder arranged together with a second communication terminal on a distant side of the communication network* (D2: abstract, lines 1-4) comprising:

- (I) *receiving from the distant side information about an encoding format currently in use on the distant side and about encoding capabilities of the*

distant side, in an initial request to bypass transcoding operations (D2: paragraph 19)

- (ii) *transmitting to the distant side information about an encoding format currently in use on the local side to enable on one or both sides a change of the encoding format currently in use prior to initiating the bypassing of the transcoding operations (D2: paragraphs 19 and 21)*

The difference between the subject-matter of claim 1 and the disclosure of D2, therefore, merely lies in the fact that:

- a. information about an encoding format currently in use on the local side is transmitted in an initial response to the initial request

This difference can, however, not be considered as involving an inventive step. The problem solved by this feature can be formulated as follows: how to perform the exchange of information concerning different encoding formats in order to obtain a common encoding format ? The solution consisting of exchanging messages that are response to each other is disclosed in D3. Indeed, in D3 which also concerns the exchange of information of encoding format in order to establish tandem free operation (see D3: abstract), messages containing this kind of information are exchanged (D3: paragraph 50, figure 1, steps TFO_REQ_L) and are sent as a response to each other. Furthermore, this feature is also suggested from figure 1 of D2.

Therefore, faced with the problem stated above and having noticed the suggestion to solve this problem in figure 1 of D2, a person skilled in the art would apply the step of D3 that consists in transmitting the response directly to the first message.

Furthermore, there is no technical benefit to transmit this message before or after the initial message because these messages consist of the transmission of messages that are not correlated: the information received in the initial message is not used in his content to determine the response. This is another reason suggesting that there is no inventive step in claim 1: it can also be considered that there is a juxtaposition of known features functioning in their normal way and not producing any non surprising effect.

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In D4, it is also suggested in page 82, figure 11.1-1 that just after the call set up procedure, the encoding capabilities on the local and distant sides are known. It is also considered as an indication that the exchange of information takes place at the initial phase of the communication, as in claim 1 of the present Application.

Independent claim 1, therefore, does not meet the requirements of Article 33(3) PCT.

2. Independent **claims 19, 21, 23, 24 and 26** are repetitions of the subject-matter of claim 1 and, hence do not meet the requirements of Article 33(3) PCT for the same reason.
3. The dependent **claims** do not seem to contain any subject-matter which, in combination with the subject of the claim on which they are dependent, would lead to a claim involving inventive activity (Article 33(3) of the PCT).

Their subject-matter is indeed either directly derivable from the above cited documents or concerns simple embodiments without inventive merit in themselves:

- (I) claims 2, 17: D2, paragraphs 19-21
- (ii) claims 3, 4, 5, 6, 10, 11, 12, 20: D1, figure 4
- (iii) claim 7: D2, paragraph 22
- (iv) claim 8, 9: D5
- (v) claim 10: D1, figure 4
- (vi) claims 13, 14: D4
- (vii) claims 15, 16 D2 abstract
- (viii) claims 18, 22, 25 and 27 are obvious embodiments

VII. Certain defects in the international application

1. To meet the requirements of Rule 5.1(a)(ii) PCT, D1-D2 should have been identified in the description and the relevant background art disclosed therein should have been briefly discussed.
2. To meet the requirements of Rule 6.3(b) PCT, the independent claims should have been **properly** cast in the **two-part form**, with those features which in combination are part of the prior art (see D1), being placed in the preamble.
3. **Reference signs** in parentheses should have been inserted in the claims to increase their intelligibility, Rule 6.2(b) PCT. This applies to both the preamble and characterising portion.
4. In order to fulfil the requirements of Rule 5.1(a)(iii) PCT, the description should have been brought into conformity with the new claims.

Furthermore, following from the disclosure of D1, the statement indicating the technical problem to be solved by the invention required a revision which should have been effected taking the requirements of Rule 5.1(a)(iii) PCT into account (cf. also PCT Guideline Chap. II 4.6).

5. The reference to the "**spirit**" of the invention should have been deleted on page 21 (PCT Guidelines Chap. III, 4.3a and Article 6 PCT).
6. The general statement "**incorporated herein by reference**" in page 17 line 37 is not clear. Therefore, either a short acknowledgement of the relevant subject-matter of the corresponding document, to which said statement refers, should in accordance with Article 34(2)(b) PCT, have been added to the description, or, if said document is not relevant for the performance of the invention, such statement should have been deleted (cf. also PCT Guidelines Chap. II. 4.17 and 6.3).

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7. A clerical error on page 6, line 7 "In case **the** of incompatible..." should have been corrected.

VIII. Certain observations on the international application

1. The various definitions of the invention given in independent claims 1, 19, 21, 23, 24 and 26, are such that the claims as a whole are not clear and concise, contrary to Article 6 PCT. The claims should be recast to include only the minimum necessary number of independent claims in any one category (Rule 6.4(a)-(c) PCT).

In the present case it is considered appropriate to use only four independent claims:

- (i) claim 1 for a method;
 - (ii) claim 21 for a computer;
 - (iii) claim 23 for a device;
 - (iv) claim 26 for a communication system.
2. **Independent claim 21** for a computer program product is not allowable. Indeed, program for computers are not patentable (see Rule 67(vi)).

However, the following formulation "A computer readable storage medium storing a set of machine executable instructions, said set of machine executable instructions being executable by a computer to perform the steps of method claims 1 to 20" is acceptable, and is recommended.